UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,703	10/23/2001	Terence Sean Sullivan		2954

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EXAMINER
NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/001,703	SULLIVAN ET AL.
Office Action Summary	Examiner	Art Unit	
	Phuoc H. Nguyen	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 October 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-9,13-16, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by

Horstmann et al. (Hereafter, Horstmann) U.S. Patent 6,779,022.

3.   Regarding claim 1, Horstmann discloses in figure 1 a method for the optimization of a

messaging system comprising a sending node (eg. communication server 105) and at least one

receiving node (eg. laptop computer 125 or wireless device 140), within a data network with a

limited resource, comprising the steps of: assigning messages a prioritization value at said

sending node (eg. server 105 receive the an email message and based on the user profile setting

(eg. priority level filter) assign a priority to the message (Figures 2 and 6; and col. 4 lines 66

through col. 5 lines 5; and col. 8 lines 36-40); identifying selected messages with a highest said

prioritization value at said sending node, and delivering said selected messages to an appropriate

said receiving node, until said limited resource is exhausted (col. 4 2nd paragraph; and col. 6 lines

46-59).

4.   Regarding claim 2, Horstmann further discloses the step of storing said selected messages

at said receiving node prior to a user request to collect selected messages from said messaging

system, thereby proactively buffering selected messages at said receiving node (col. 9 lines 7-20).

5.   Regarding claim 3, Horstmann further discloses the step of decomposing messages into message elements at said sending node, and then processing each said message element as an independent message (col. 8 lines 20-36).

6.   Regarding claim 4, Horstmann further discloses decomposition divides messages into said message elements comprising a header comprising at least a sender messaging address identifier and a message subject, a first message section, comprising no more than a predetermined amount of data, and a second message section (col. 8 lines 55-65).

7.   Regarding claim 5, Horstmann further discloses prioritization value depends upon the type of said message element (col. 8 lines 25-40).

8.   Regarding claim 6, Horstmann further discloses he full text of said message is provided to a set of messaging nodes that is a smaller subset of the messaging nodes provided with a header of said message (col. 8 last paragraph through col. 9 2nd paragraph).

9.   Regarding claim 7, Horstmann further discloses limited resource comprises communications time between said sending node and said receiving node (col. 10 lines 6-15).

10.   Regarding claim 8, Horstmann further discloses limited resource comprises collective communications bandwidth from said sending node (Figure 5).

11.   Regarding claim 9, Horstmann further discloses limited resource comprises storage capacity on said receiving node (col. 8 lines 55-61).

12.   Regarding claim 13, Horstmann further discloses prioritization value depends upon an

association table value for relating said receiving node and a message recipient, and prioritization

value is greater for administrative messages (col. 7 lines 64-67).

13.   Regarding claim 14, Horstmann further discloses prioritization value depends upon the

payment of a surcharge for the express delivery of said message (col. 8 lines 55-65).

14.   Regarding claim 15, Horstmann further discloses prioritization value is greater for

administrative messages (col. 7 lines 64-67).

15.   Regarding claim 16, Horstmann further discloses prioritization value depends upon the

geographic location of said receiving node (Figure 4).

16.   Regarding claim 19, Horstmann further discloses sending node comprises a central server

in a messaging system (Figure 1, communication server).

17.   Regarding claim 20, Horstmann further discloses receiving node comprises a portable

messaging unit including user interface means and storage means, operated by a message

recipient (Figure 1, wireless device).

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

19.   Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann

in view of Ueno et al (Hereafter, Ueno) U.S. Patent 6,226,670.

Horstmann disclose identifying selected messages with a highest said prioritization value at said sending node; however, Horstmann fails to teach the prioritization value depends upon the age, service level of the sender, of said message.

Ueno discloses the prioritization value depends upon the age, service level of the sender, and service level of the recipient of said message (Figures 11-13; and col. 2 lines 59-65).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Ueno's teaching into Horstmann's method to set the priority level based upon the age, the service level of the sender, and the service level of the recipient in order to categorize messages and level of emergency degree so the recipient act on based upon the level of priority.

20.   Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann in view of Horvitz et al (Hereafter, Horvitz) U.S. Patent 6,161,130.

Horstmann disclose identifying selected messages with a highest said prioritization value at said sending node; however, Horstmann fails to teach the prioritization value depends upon the predicted probability based upon prior behavior that said recipient will request the collection of incoming messages at said receiving node, and the message provided to said receiving node when said prioritization value exceeds a predetermined threshold.

Horvitz teaches prioritization value depends upon the predicted probability based upon prior behavior that said recipient will request the collection of incoming messages at said receiving node, and the message provided to said receiving node when said prioritization value exceeds a predetermined threshold (col. 4 lines 40-53; and col. 13 lines 57 though col. 14, lines 42).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention was made to incorporate Horvitz's teaching into Horstmann's method to predicted

probability based upon prior behavior, and provided message to receiving node when the

threshold is exceeded, as a result it provides an accurately and automatically detect and classify

the incoming email messages.

Conclusion

21.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Haneda et al. U.S. Patent 6,189,027

Hirosawa et al. U.S. Patent 6,418,465

Eggleston et al. U.S. Patent 6,101,531

Wang et al. U.S. Patent 6,442,593

Raghunandan U.S. Patent 6,816,885

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919.

The examiner can normally be reached on Mon -Thu (7AM-4: 30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A Wiley can be reached on 571-272-3923. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H. Nguyen
Examiner
Art Unit 2143

December 17, 2004

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100